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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,712	01/21/2004	Eric M. Breitung	08CL7395-11	5212
23413	7590	09/15/2004		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER ANGEBRANDT, MARTIN J	
			ART UNIT	PAPER NUMBER

1756

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/762,712		BREITUNG ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Martin J Angebrannt		1756	

SC

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/21/2004</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

**A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.**

2. Claims 1,4-20 and 25-32 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,3-18,20-23,28-30 of prior U.S. Patent No. 6733950. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,4-21 and 25-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6733950. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20 and 28 of the reference recite all of the materials limitations of the instant claims, but do not describe the reflectivity afterwords as being 45%. The examiner holds that this is inherent to the material of the PMMA/methylene blue embodiment, which is already

covered by U.S. Patent No. 6733950. The examiner also notes that this limitation is found in other claims. The examiner similarly holds that the resistance to bleaching is an inherent property of the reactive layer compositions recited in the claims of U.S. Patent No. 6733950.

5. Claims 1,4-21 and 23-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6733950 in view of Higuchi et al. '505.

The claims, in particular claim 1 and 19, recite a data storage layer between the reflective layer and the substrate. Claims 20 and 31 also recite a data storage layer.

Higuchi et al. '505 teaches the use of various recording layer materials including magneto-optic materials, such as GdCo, GdFe, TbFeNi, BiSmErGa iron garnet (5/25-40) and phase change optical recording layers (5/41-55).

The claims of the patent maturing from the parent application recite a data storage layer, but do not recite a particular type of data storage layer to be protected by the means recited. The examiner holds that it would have been obvious to one skill in the art to modify the claimed invention of U.S. Patent No. 6733950 by using a magneto-optic or phase change recording layer, such as those disclosed by Higuchi et al. '505 with a reasonable expectation of forming a useful writable optical recording medium.

6. Claims 1,4-22 and 25-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6733950 in view of Takagishi et al. '844.

The claims, in particular claim 1 and 19, recite a data storage layer between the reflective layer and the substrate. Claims 20 and 31 also recite a data storage layer.

Takagishi et al. '844 teach the use of cyanine dyes based upon recording media, which have very stable recordability and high reflectivity.

The claims of the patent maturing from the parent application recite a data storage layer, but do not recite a particular type of data storage layer to be protected by the means recited. The examiner holds that it would have been obvious to one skill in the art to modify the claimed invention of U.S. Patent No. 6733950 by using a cyanine dyes based , such as those disclosed by Takagishi et al. '844 with a reasonable expectation of forming a useful writable optical recording medium.

7. Claims 1-22 and 25-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6733950 in view of Kanno et al. EP 0274092 and/or Okamoto '903.

Claims 4,5,24 and 25 all recite polycarbonate.

Kanno et al. EP 0274092 teach polycarbonate formed from 2,2-bis(4-hydroxy-3-tert-butylphenyl)propane copolymerized with other polycarbonate forming monomers, including 1,1-bis(hydroxyphenyl)cyclohexane. The resulting polycarbonates are disclosed as useful in forming optical recording media substrates due to their low birefringence (double refraction). (1/8-52)

Okamoto '903 teaches polycarbonate formed from various polycarbonate forming monomers, including 1,1-bis(hydroxyphenyl)cyclohexane. The resulting polycarbonates are disclosed as useful in forming optical recording media substrates due to their low birefringence (double refraction). (1/66-2/10 and 2/55).

The claims of the patent maturing from the parent application recite a polycarbonate substrate, but do not recite a particular type of data polycarbonate. The examiner holds that it

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would have been obvious to one skill in the art to modify the claimed invention of U.S. Patent No. 6733950 by using the polycarbonates disclosed by Kanno et al. EP 0274092 and/or Okamoto '903, which are disclosed as having low birefringence and suitable for forming optical disc substrates with a reasonable expectation of realizing the benefits ascribed to substrates formed from these polycarbonates.

8. Claims 1-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6733950 in view Kanno et al. EP 0274092 and/or Okamoto '903 combined with either Takagishi et al. '844 or Higuchi et al. '505.

The claims, in particular claim 1 and 19, recite a data storage layer between the reflective layer and the substrate. Claims 20 and 31 also recite a data storage layer.

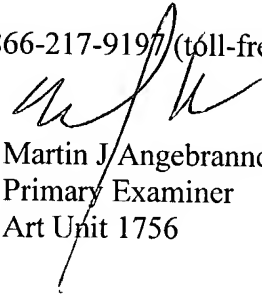
In addition to the basis provided directly above, the examiner notes that the claims of the patent maturing from the parent application recite a data storage layer, but do not recite a particular type of data storage layer to be protected by the means recited. The examiner holds that it would have been obvious to one skill in the art to modify the claimed invention of U.S. Patent No. 6733950 by using a cyanine dyes based , such as those disclosed by Takagishi et al. '844 with a reasonable expectation of forming a useful writable optical recording medium.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J. Angebrannndt  
Primary Examiner  
Art Unit 1756

09/13/2004